



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

(M)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,157	02/15/2002	Markus Pompejus	48684 DIV	9944
26474	7590	03/17/2004	EXAMINER	
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			STEADMAN, DAVID J	
		ART UNIT		PAPER NUMBER
		1652		
DATE MAILED: 03/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/076,157	POMPEJUS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	David J Steadman	1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 4 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1 and 4 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 09/212,247.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status of the Application*

- [1] Claims 1 and 4 are pending in the application.
- [2] Applicants' amendment to the claims to cancel claims 2-3 and 5-29 and amend claim 4, filed February 15, 2002, is acknowledged.
- [3] Receipt of a sequence listing in computer readable form and paper copy and statements of their sameness and that the substitute sheets contain no new matter, filed April 05, 2002, is acknowledged.
- [4] The specification is objected to as applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 121 as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

If applicant desires priority under 35 U.S.C. 121 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

***Election/Restrictions***

- [5] Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claim(s) 1 and 4, drawn to an isolated or purified protein having the sequence of SEQ ID NO:2 or a variant thereof having lysine at position 7 replaced with valine, classified in class 435, subclass 194.
  - II. Claim(s) 1 and 4, drawn to an isolated or purified protein having the sequence of SEQ ID NO:2 or a variant thereof having aspartate at position 52 replaced with histidine, classified in class 435, subclass 194.
  - III. Claim(s) 1 and 4, drawn to an isolated or purified protein having the sequence of SEQ ID NO:2 or a variant thereof having leucine at position 133 replaced with isoleucine, classified in class 435, subclass 194.
  - IV. Claim(s) 1 and 4, drawn to an isolated or purified protein having the sequence of SEQ ID NO:2 or a variant thereof having aspartate at position 186 replaced with histidine, classified in class 435, subclass 194.
  - V. Claim(s) 1 and 4, drawn to an isolated or purified protein having the sequence of SEQ ID NO:2 or a variant thereof having alanine at position 193 replaced with valine, classified in class 435, subclass 194.
  - VI. Claim(s) 1 and 4, drawn to an isolated or purified protein having the sequence of SEQ ID NO:2 or a variant thereof having histidine at position 196 replaced with glutamine, classified in class 435, subclass 194.
- [6] The inventions are distinct, each from the other because:

[7] The variant polypeptides of Groups I-VI are structurally distinct and no single variant polypeptide of Groups I-VI would render the others obvious to one of ordinary skill in the art.

[8] MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, each of the inventions of Groups I-VI are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. Because each of the variant polypeptides of Groups I-VI is structurally distinct, each of the inventions of Groups I-VI requires a separate patent and non-patent literature search requiring a different text and sequence search for each invention and thus, co-examination of the inventions of Groups I-VI would require a serious burden.

### ***Conclusion***

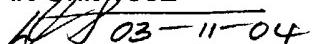
[9] Claim 4 will be examined only to the extent the claim reads on the elected subject matter.

[10] Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

[11] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman  
Patent Examiner  
Art Unit 1652

  
11/03-11-04